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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,008	07/09/2001	Yoshiyuki Shino	35.C15536	4382 11
5514	7590	09/12/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DICUS, TAMRA	
		ART UNIT	PAPER NUMBER	
		1774		

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/900,008	SHINO ET AL.
	Examiner Tamra L. Dicus	Art Unit 1774

-- The MAILING DATE of this communication app ars on the cover sheet with the correspond nce addr ss --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 August 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14-21 is/are pending in the application.

4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to the amendment filed 8-25-03. The prior Office Action mailed April 24<sup>th</sup> 2003, Paper No. 9, was unintentionally entered as a final rejection. The Examiner grants the request to withdraw the finality of the April 24<sup>th</sup> 2003 Office Action. This Office Action will be treated as if the prior Office Action was non-final. The claim objection is withdrawn due to Applicant's amendment.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17 and 18 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,254,525 to Nakajima et al.

3. Nakajima teaches a thermal transfer image-recording material for an ID card. The card is layered in the following order: a support, an adhesive (equivalent barrier/base material functionality), image-receiving layer with an ink sheet/layer over to form the image (ink receiving). The IC memory is on the support. See col. 1, lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, col. 10, lines 15-60.

4. The new limitation now provides the ink is applied with an ink jet head. Such process limitations as "applying ink with an ink jet head" is not limited to the specific method step, but

only to the structure implied by the step. For example, the structure includes in this order: an IC, a barrier, and an ink receiving layer, which the prior art provides. See MPEP 2113.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,254,525 to Nakajima et al. in view of USPN 4,841,134 to Hida et al.

Nakajima teaches a thermal transfer image-recording material for an ID card. The card is layered in the following order: a support, an adhesive, a cushion or barrier layer, image-receiving layer with an ink sheet/layer over to form the image (ink receiving), optional peeling layer of silicone resin and ink sheet. The IC memory is on the support. See col. 1, lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, col. 10, lines 15-60. At col. 15, lines 10-30, the barrier layer is taught by Nakajima to be between 1 and 50 microns, meeting Applicant's claimed range from 0.5 to 20 microns of claim 16. The barrier layer is used to prevent dye diffusion, the same as Applicant claims. Nakajima also teaches at col. 17 a subbing layer which may serve as a barrier material.

Nakajima does not teach a barrier material between an IC and base material. Hida teaches an IC card comprising in the following order: an oversheet 2b, a reinforcing sheet (equivalent to base material), adhesive (6), and IC (4). Hida teaches a reinforcing member 5 or sheet 8 is provided to cover the boundary between the card substrate (base material) and the IC

module see col. 2, lines 29-45 and col. 3, line 43-col. 4, line 30. Either reinforcing 5 or 8 functions as a barrier structured as instant independent claims 14 and 17. See col. 3, line 43- col. 4, line 30. The reinforcing sheet may be a mesh-like sheet is a knitted or woven resinous material used to promote adhesion and serve to increase the thickness of the card. The reinforcing sheet may be 10-500 micrometers thick. Hence it would have been obvious to one of ordinary skill in the art to modify the image-recording material with a barrier material between an IC and base material, where a base material is of a reinforcing mesh-like material for the purpose of providing an alternative construction as seen in Figures 1a-1d and Figures 6 & 7, further promoting adhesion and serve to increase the thickness of the card as taught by Hida. Regarding the air permeability property of claim 15 and 19, Nakajima is silent to teaching a barrier layer having an air permeability property being measured by Gurley test method (new limitation). However, such property is optimizable as it depends upon the fibrous spacing of the filaments in a nonwoven sheet. Hence it would have been obvious to one of ordinary skill in the art to modify the recording material of Nakajima to include a layer having air permeability properties since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Air permeability is effected by filament spacing in a nonwoven sheet.

Regarding new claim 20, that ink-jet recording can be carried out/is able to be is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding new claim 21, that the recording medium is used as a non-contact tag , it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

7. Applicant contests that the IC memories is provided on the support of Nakajima. Applicant further contests that Nakajima does not teach or suggest an ink receiving layer is thick enough to prevent ink applied to the ink receiving layer from reaching the electronic information storing circuit (IC). The Applicant has not persuasively argued. The invention of Nakajima discloses the following structure in this order: a support, an adhesive (equivalent barrier/base material functionality), image-receiving layer with an ink sheet/layer over to form the image (ink receiving). The IC memory is on the support. See col. 1, lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, col. 10, lines 15-60. Indeed “on” means on the outer surface. Therefore, the above-recited structure is the same as Applicant’s instant claim 17 and 18. The thickness of the image-receiving layer is 1 to 50 microns at col. 7, lines 1-2. The Applicant’s disclosure states a range of 1-100 microns on page 19, therefore, the ink that is applied to the image-receiving layer of Nakajima provides the same functionality, e.g. “thick enough to prevent ink applied to the ink receiving layer from reaching the electronic information storing circuit (IC)” since the exact same structure is provided as instantly claimed.

8. Regarding claim 18 over Nakajima, applicant alleges that since the amended claim now provides the ink is applied with an ink jet head, that this amendment provides no patentable distinction over the prior art because it is a process limitation. Such process limitations as

“applying ink with an ink jet head” is not limited to the specific method step, but only to the structure implied by the step. For example, the structure includes in this order: an IC, a barrier, and an ink receiving layer, which the prior art provides. See MPEP 2113. Conclusively, withdrawal of the 102(b) rejection is denied.

9. Applicant further alleges Hida (over the amended claims 14 and 19) does not teach or suggest the barrier layer having an air permeability of at least 300 sec/100 cc and provides no motivation to combine the references dealing with the technical problem that may occur over the ink applied to an ink receiving layer adversely influences the IC module. The Applicant has not persuasively argued. The amendment now provides a barrier layer between the IC and a base material. Hida still meets this limitation because Hida teaches a reinforcing member 5 or sheet 8 is provided to cover the boundary between the card substrate (base material) and the IC module see col. 2, lines 29-45 and col. 3, line 43-col. 4, line 30. Either reinforcing 5 or 8 functions as a barrier structured as instant independent claims 14 and 17. Regarding the air permeability of at least 300 sec/100 cc, as previously stated, such a property is optimizable as it depends upon the fibrous spacing of the filaments in a nonwoven sheet. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Air permeability is effected by filament spacing in a nonwoven sheet.

10. In reply to the motivation allegation, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert.*

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*denied*, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references “without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done” (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. Both Hida and Nakajima are analogous art in the technical field of IC card manufacture. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Similar materials and constructions are provided in both references and hence one would be motivated to produce the claimed invention. The differences of Nakajima are mitigated by Hida.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus  
Examiner  
Art Unit 1774

September 8, 2003

CYNTHIA H. KELLY  
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